UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,136	07/28/2006	Yoshiaki Kumamoto	280999US0PCT	5996

22850 7590 10/05/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
SMITH, KAITLYN ELIZABETH	

ART UNIT	PAPER NUMBER
3739	

NOTIFICATION DATE	DELIVERY MODE
10/05/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/556,136	KUMAMOTO ET AL.	
	Examiner	Art Unit	
	KAITLYN SMITH	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 August 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1-5,7-10,12-16,18 and 19* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☒ Claim(s) *12-16 and 18* is/are allowed.

7)☒ Claim(s) *1-5,7-10 and 19* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on august 23, 2010 has been entered.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 4, 5, 7-10 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Publication No. 01-201253 to Yahara et al. (Yahara) which for the sake of clarity, reference will be made to the English language translation supplied with this Office Action in view of U.S. 2001/0049546 A1 to Dvoretzky et al. (Dvoretzky).

Regarding claims 1 and 2, Yahara teaches a warming article having a heat generating main body comprising a heat generating element (Fig. 1 and Claims) configured to generate water vapor (inherent in that there is water disposed in the main body and sufficient heating as taught on pg. 10 to cause vaporization) an air permeable holder (2, Fig. 1 and Pg. 8) including an air permeable layer and an air impermeable layer (Pg. 8) which are disposed on opposite sides of the heat generating element (Pg.

8), the heat generating main body expandable by water vapor generated with the heat generation of the heat generating element (Claims and Industrial Field of Application). However, Yahara does not teach a receiving part configured to receive a part of the body which is provided on the air permeable side of the holder. Dvoretzky teaches a multi-purpose drug and heat delivery system (title) including a receiving part (Figs. 1-4 and [0015 and 0041-0044]) including a receiving member (21) joined to the heat generating main body forming an insertion opening (Figs. 1-4). The receiving part of Dvoretzky would necessarily be provided on the air permeable side of the heat generating element as it is the air permeable side of the heating element that is going to provide heat treatment to the body part. In Dvoretzky, the body retaining element is in contact with the air impermeable side and the air permeable side (Fig. 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Yahara to have included the receiving part of Dvoretzky as Dvoretzky teaches that the receiving part securely maintains the heating element in the desired location, assisting in regulating and controlling the heat level and air transmission enabling a controlled heat delivery ([0028]).

Regarding claim 7, Yahara teaches a warming article having a heat generating main body comprising a heat generating element (Fig. 1 and Claims) configured to generate water vapor (inherent in that there is water disposed in the main body and sufficient heating as taught on pg. 10 to cause vaporization) an air permeable holder (2, Fig. 1 and Pg. 8) including an air permeable layer and an air impermeable layer (Pg. 8) which are disposed on opposite sides of the heat generating element (Pg. 8), the heat

generating main body expandable by water vapor generated with the heat generation of the heat generating element (Claims and Industrial Field of Application). However, Yahara does not teach a receiving part configured to receive a part of the body which is provided on the air permeable side of the holder. Dvoretzky teaches a multi-purpose drug and heat delivery system (title) including a receiving part (Figs. 1-4 and [0015 and 0041-0044]) including a receiving member (21) joined to the heat generating main body forming an insertion opening (Figs. 1-4). The receiving part of Dvoretzky would necessarily be provided on the air permeable side of the heat generating element as it is the air permeable side of the heating element that is going to provide heat treatment to the body part. In Dvoretzky, the body retaining element is in contact with the air impermeable side and the air permeable side (Fig. 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Yahara to have included the receiving part of Dvoretzky as Dvoretzky teaches that the receiving part securely maintains the heating element in the desired location, assisting in regulating and controlling the heat level and air transmission enabling a controlled heat delivery ([0028]).

However neither Yahara nor Dvoretzky teaches the warming article generating 1.0 to 100 mg/(cm^2x10 min.) of water vapor. However, the warming article by Yahara is capable of producing water vapor in this range as the amount of water vapor produced is a function of material choice and the concentration of various components of the pulp mixture disclosed. It would be a matter of routine experimentation and design choice to produce a warming article as taught by Yahara which has a water vapor production

within the claimed range. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have made a warming article that is capable of generating the desired water vapor as a matter of course in optimizing the invention (see MPEP 2144).

Regarding claims 4 and 9, Yahara in view of Dvoretzky teaches the article of claims 1 and 7 above, with Yahara teaching the further limitation of the method of producing a warming article comprising a heat generating element prepared by papermaking and containing an oxidizable metal, a moisture-retaining agent, a fibrous material, and water (Claims, Industrial Field of Application and Pgs. 4 and 6).

Regarding claim 8, Yahara in view of Dvoretzky teaches the article of claim 7, with Yahara teaching the further limitation of the holder having an air permeability of 10000 sec/100 ml or less (Pg. 11).

Regarding claims 5 and 10, Yahara in view of Dvoretzky teaches the article of claims 4 and 9, as well as Yahara teaching the molded sheet containing at least 50% by weight of components other than the fibrous material (Pg. 6), but not the fibrous material having a CSF of 600ml or less (This is a property of pulp drainage and the Office has no way of measuring the CSF of the pulp used in Yahara. The burden rests on applicant to provide proof if the fibrous material disclosed in Yahara does not have this property and the claimed property renders the claimed invention patentably distinct from that taught by Yahara). In the event that the fibrous material taught by Yahara does not have a CSF of 600 ml or less, it would have been obvious to one having ordinary skill in the art

at the time of the invention to have used such a fibrous material as a matter of design choice as such properties are easily obtainable in pulp minerals as taught by Yahara.

Regarding claim 19, see the rejection of claim 7 with respect to the placement of the receiving part in conjunction with the layers.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yahara et al. and Dvoretzky as applied to claim 1 above, and further in view of Japanese Patent Application Publication No. 2002-078728 to Toru et al. (Toru).

Yahara in view of Dvoretzky teaches the article of claim 1, but not the moisture or water permeability within the range of 1.5 to 10 kg/(m^2x24 hr). Toru teaches a warming article with air permeability that has a moisture permeability within the range of 1.5 to 10 kg/(m^2x24 hr). It would have been obvious to one having ordinary skill in the art at the time of the invention to have further modified Yahara and Usui with the moisture/water vapor permeability of Toru as Toru teaches that steam generation in a warming article to be applied to the skin is advantageous (Claims).

Allowable Subject Matter

5. Claims 12-16 and 18 allowed.

Response to Arguments

6. Applicant's arguments filed August 23, 2010 with respect to claims 12-16 and 18 have been considered and are persuasive. Therefor the rejection of April, 21, 2010 has been withdrawn.

7. Applicant's arguments filed August 23, 2010 have been fully considered but they are not persuasive.

a. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the receiving part imparts a structure as in Fig. 2 of the application) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

b. Regarding applicant's argument on page 10 of the remarks/arguments, the examiner maintains the rejection. The examiner is not stating that the maximum stress and breaking elongation parameters are optimum values that resulted from routine experimentation by one of ordinary skill in the art. The examiner is taking the position that the maximum stress and breaking elongation parameters would result from an obvious design choice among readily available materials to one having ordinary skill in the art as no unique structure is disclosed.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAITLYN SMITH whose telephone number is (571)270-5845. The examiner can normally be reached on Monday - Friday 9:00 a.m. to 5:30 p.m. EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571)272-4764. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KAITLYN SMITH/
Examiner, Art Unit 3739

/Roy D. Gibson/
Primary Examiner, Art Unit 3739